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| 10/795,896 | 03/08/2004 | Alejandro Freire | 50815/DRK/K443 | 1525 |
| 23363 | 7590 | 12/12/2006 | EXAMINER | |
| CHRISTIE, PARKER & HALE, LLP | | | PHAM, HUONG Q | |
| PO BOX 7068 | | | ART UNIT | |
| PASADENA, CA 91109-7068 | | | PAPER NUMBER | |
| | | | 3772 | |

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/795,896

Applicant(s)

FREIRE, ALEJANDRO

Examiner

Huong Q. Pham

Art Unit

3772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-19 and 21-23 is/are rejected.
- 7) ☒ Claim(s) 9, 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 11, 13, 15-16, 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Towbin (3,522,804).

Towbin teaches a brace body 10 comprising a flexible material which can be made of rubber or rubber like plastic material with plurality of tunnels (figure 4) capable of being stretched to have a larger internal diameter, and plurality of inserts 15, two engaging members 10a, 10c (note figures 3, 4), 2 side edges (next to reference # 13 , and note that “ vicinity “ is a relative word), sections of material 11, complementary attachment means 13.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-6, 10-17, 21- 23 are rejected under 35 U.S.C. 102(b) as being anticipated by, or 35 U.S.C. as being unpatentable over Sarkozi (5,211,623).

Sarkozi teaches a brace body comprising a flexible material 27 which can be made of plastic material with plurality of tunnels (figure 9) capable of being stretched to have a larger internal diameter, and plurality of inserts, two engaging members 21, 22, 23, 24, a chin cup (note figure 7).

Claims 1 -6, 10-17, 21- 23 are rejected under 35 U.S.C. 103 as being unpatentable over Santos (4,881,529) in view of Towbin (3,522,804), or Nakamura et al (6,027,467), or Nessler (1,473,506) .

Santos teaches a brace body comprising a flexible material with plurality of tunnels (perforated leather material) capable of being stretched to have a larger internal diameter, and at least one elongated insert 20,22, 24, 26, 28, 29, 30 as recited in claim 1.

Towbin, Nakamura, and Nessler teach use of pliable plastic or silicone rubber for a neck brace. In view of the teaching of Towbin, Nakamura, or Nessler, it would have been obvious to one ordinary skill in the art at the time the invention was made to substitute the leather layer 21, 17, 41 (the layer which covers tubes 20,22,24,26,28,29,30 or covers the pads 38, 12 : note figures 4- 6) for pliable plastic or silicone rubber material in order to provide better support to a user . The substitution of one material for another material based on its well-known properties is well within the realm of one ordinary skill in the art, and does not provide any unobvious result, and

therefore is not patentable over prior art. Note in figures 4 –6 that layer 17, 21, 41 has a smooth and generally flat inner wall (for layer 21, note that this layer has plural small sections which form a “generally flat “ inner wall when the brace is pressed and worn around the neck of a user). As for claims 2-3, note that Santos ‘ device has two side edges (figure 1) , top and bottom edges, two engaging members 18, 36, 12, 38. As for claim 12, note chin cup 34 (figure 2).

Claims 7- 8, 18- 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Santos (4,881,529) in view of Veylupek (5,755,044).

Note the comments above for the teaching of Santos.

Veylupek teaches a device with a string 14 that are passed through guide tubes 84a , 84b, 80, 82 (figure 13) . In view of these teachings of Veylupek , it would have been obvious to one ordinary skill in the art at the time the invention was made to provide the device of Santos with connecting means having strings that are passed through tubes in the tunnels in order to adjust and connect the side edges together.

Claims 1, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox (3,964,474) in view of Towbin (3,522,804), or Nakamura et al (6,027,467), or Nessler (1,473,506) ..

Fox teaches a brace body comprising a flexible material with at least one tunnel 20 capable of being stretched to have a larger internal diameter, and at least one elongated insert 10, a chin cup 19.

Towbin, Nakamura, and Nessler teach use of pliable plastic or silicone rubber for a neck brace. In view of the teaching of Towbin, Nakamura, or Nessler, it would have been obvious to one ordinary skill in the art at the time the invention was made to substitute the member 20 of Fox for pliable plastic or silicone rubber material in order to provide better support to a user. The substitution of one material for another material based on its well-known properties is well within the realm of one ordinary skill in the art, and does not provide any unobvious result, and therefore is not patentable over prior art.

Claims 5 –6, 10, 12, 14, 17, 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable Towbin (3,522,804) in view of Santos (4,881, 529), Obujen (5,410,755), or Newman (4,219,193).

Santos , Obujen , and Newman teach brace with flexible elongate tube insert for reinforcing the brace. Newman and Santos teach brace with chin cup. Santos teaches neck brace with various diameter tubes. In view of the teachings of Santos , Obujen , or Newman, it would have been obvious to one ordinary skill in the art at the time the invention was made to provide these structures to the brace of Towbin in order to reinforce the brace and to provide support for the chin of a user.

Claims 4, 7-9 , 16 are objected to because " the two engaging means" (claims 4, 16) , and "the tunnels" (claim 7) the lacks proper antecedent basis.

Allowable Subject Matter

Claims 9, 20 are objected to as being dependent upon a rejected base claim, and as being dependent on the objected claim(s), but would be allowable if rewritten in independent form to overcome all the objection, and to include all of the limitations of the base claim and any intervening claims

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huong Q. Pham whose telephone number is (571) 272-4980. The examiner can normally be reached on 8:45 AM - 5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571) 272 - 4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

December 6, 2006



MICHAEL A. BROWN
PRIMARY EXAMINER